

### REMARKS

The matters raised in the Office action are discussed below in the same order as presented by the Examiner.

In response to the request for corrected drawings, a substitute set of drawings is presented. The substitute drawings include proper drawing symbols for cross-sections of concrete, foam insulation and plastic.

In response to the rejection under 35 USC 112, second paragraph, claims 6-9 have been amended herein to conform them with US claim style. As amended, the claims are directed to a heat insulation panel that also serves as a mold wall or mold form for the outdoor side of a concrete wall or wall body. The heat insulation panel comprises an integral assembly of a heat insulation material and a plastic reinforcing panel installed on the outdoor side of the heat insulation panel. Further amendments to the claims are discussed below.

For the Examiner's convenience, it is further noted that each of the independent claims has been amended to make clear that the plastic reinforcing panel is on the outdoor side of the heat insulation material. In addition, each of the independent claims has been amended to recite that the groove-like air passage sections have a U-shape cross-section with elongate openings disposed against and

open to the outdoor side of the heat insulation material (claim 6), having the cross-section open to and extending along the outdoor side of the heat insulation material (claim 10) or the cross-section including elongate openings disposed against and open to the heat insulation material (claim 11). This arrangement is shown in each of the embodiments illustrated in the drawings and discussed throughout the specification. Moreover, in the paragraph bridging pages 6 and 7 of the specification, the discharge of indoor dew condensation and/or outdoor rainwater through the air passage sections is also described.

Claim 12 has been further amended to recite that the spaced walls have in-turned wall ends and separator cones mounted within the air passage sections that project between the wall ends. The separator cones temporarily engage tie bolts to fix the position of the integral assembly and the molding form during placing of concrete. This arrangement is particularly described at pages 6 - 11 of the specification with respect to Figs. 6-10.

Claim 18 has also been amended to recite the use of separator cones. New claim 19 also recites that the spaced walls have in-turned ends that engage and retain the separator cones in the air passage sections. The foregoing elements and arrangements are discussed at pages 6-11 of

the specification with respect to Figs. 6-10 as noted above.

Turning to the claim rejections based on prior art, it is submitted that the rejection of claims 11 - 13 and 16 - 18 under 35 USC 102(b) as anticipated by JP1994-6530 is overcome by amendment. The '530 teaching does not disclose that the plastic reinforcing panel is mounted on the outdoor side of the heat insulation material as set forth in each of the claims.

The rejection of claim 6 - 10 and 14 - 15 under 35 USC 103(a) as unpatentable over '530 in view of EP 0,048,428 is in error. As discussed below, there is no motivation to combine the teachings of the '530 and '428 references. In fact, '530 and '428 are not properly combinable since the combination would destroy the intended function of '530 as held by the court in *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1894). Moreover, even if the teachings are combined, the combination does not result in the claimed invention.

The '530 teaching contemplates a heat insulation panel 1 intended to provide a mold wall or support surface for forming the concrete wall 27. In '428, the fiber insulation felt panel 1 is applied to the concrete wall 4 after the wall has been formed. The felt panel 1 does not

provide a mold wall or support surface for forming the concrete wall 4. Accordingly, there is no motivation to modify the heat insulation panel 1 and concrete wall 27 of '530 in view of the felt panel 1 and concrete wall 4 of '428. One skilled in the art is not motivated by any utility, function or other attribute of the felt panel 1 in '428 to modify or alter the heat insulation panel 1 in '530. Such a modification is only supported by applicant's own teachings.

In the rejection, it is urged that one skilled in the art would combine the teachings in '530 and '428 to move the heat insulation panel 1 in '530 to the outdoor side of the concrete wall 27. Even assuming the motivation for this modification, the combination does not result in the claimed invention. The filter member 6 remains disposed against the surface of the concrete wall 27 to keep concrete out of the discharge slot or drain 5 as taught in '530. As also taught in '530, the filter member 6 serves to pass moisture from the concrete into the discharge slot or drain 5 in accordance with the water cement ratio. Thus, the ordered arrangement of the elements forming the panel 1 relative to the concrete wall 27 in '530 remain the same in accordance with the specific patent teachings and

functions and the combination does not result in the claimed invention.

More particularly, it is a basic teaching in '530 that the discharge of moisture from the concrete is influenced by the water cement ratio, and that such moisture is received in drain 5. In paragraph [0020] of '530, it is taught that the width "X" and depth "D" of the drain 5 are determined in accordance with a water cement ratio. Therefore, '530 teaches that the drain 5 is open to the concrete wall 27 and covered with the moisture passing filter member 6 to prevent the entry of concrete into the drain 5.

In view of the above specific teachings in '530, it is respectfully submitted that there is no modification of '530 that will result in the claimed air passage sections having a U-shape cross-section with elongate openings disposed against and open to the outdoor side of the heat insulation material (claim 6), having the cross-section open to and extending along the outdoor side of the heat insulation material (claim 10) or the cross-section including elongate openings disposed against and open to the heat insulation material (claim 11). Contrarily, the specific teaching in '530 is that the drain 5 is open to

the concrete in order to receive discharge water from the concrete in accordance with the water cement ratio.

Applicant respectfully disagrees with the Examiner's position that it would have been "obvious to a person of ordinary skill in the art to configure the structure of '530 to have a heat insulation panel positioned on the interior side of the reinforcing panels adjacent the concrete structure as taught by '428". There is no reinforcing panel and no such teaching in '428.

In the absence of a reinforcing panel in '428, there is also no comparable air passage teaching supporting the repositioning of the drain 5 in '530. As noted above, even if a prior art teaching of relocating the drain 5 was found, it would conflict with the basic teachings in '530 and the combination would not provide the basis of a proper rejection for the claims of record.

In view of the specific teachings in '530 with regard to the receipt of concrete moisture discharge in the drain 5, the proposed modifications separating the drain 5 from the concrete is not a mere reversal of essential working parts of a device involving only routine skill in the art as opined by the Examiner. Contrarily, it is a major modification that conflicts with the specific teachings, mode of operation and matter upon which the invention is

based in the '530. A prior art rejection based on such a combination of teachings and modification of '530 is improper since it destroys the intended function of '530. See *In re Gordon, supra*.

For at least the foregoing reasons, all of the claims of record are patentably distinguished over the prior art.

In addition to the foregoing reasons, claims 12, 18 and new claim 19 are further patentably distinguished over the prior art by the separator cones recited therein. The separator cones are received within the air passage sections in accordance with the invention. As described in the present specification at page 12, lines 12 - 16, use of the separator cones avoids the extension of one end of the separator 9 from the surface of the reinforcing panel 3. This facilitates the mounting of external cladding.

Lastly, it is again urged that the prior art does not teach a plastic reinforcing panel including a generally flat sheet for receiving an exterior finish of the wall as particularly defined in claims 10 and 12. More particularly, claim 10 includes the following recitations: "said plastic reinforcing panel including a generally flat sheet ..." and "said flat sheet being spaced from said heat insulation material by said projecting spaced walls for receipt of said exterior finish". Referring to claim 12,

the plastic reinforcing panel is defined to include "a generally flat sheet" and "said flat sheet being located and exposed at said outdoor side of said wall structure to receive said exterior finish".

For all of the foregoing reasons, is respectfully submitted that all of the claims presently of record are in condition for allowance and such action is requested.

An Information Disclosure Statement and fee for the same are also submitted at the time of this electronic submission.

If any additional fees are required by this communication, please charge such fees to Deposit Account No. 16-0820, Order No. 41089.

Respectfully submitted,

By:   
Joseph J. Corso, Reg. No. 25845

1801 East Ninth Street  
Suite 1200  
Cleveland, Ohio 44114-3108

(216) 579-1700

September 17, 2009